

### **REMARKS**

Claims 1, 13, and 30 have been amended herein. Claim 29 is cancelled herein. Claims 3, 6-8, 14-17, 23, 25, 26, 28, and 32-42 are withdrawn without prejudice in view of the restriction and species election. Claims 43 - 48 have been added. The Abstract has been replaced by a new Abstract.

Upon entry of this paper, claims 1, 2, 4, 5, 9-13, 18-22, 24, 27, 30, 31, and 43-48 will be pending and under consideration.

Claim 1 has been amended to correct typographical errors and to remove element “g) C<sub>1-8</sub> acyl” from the Markush Group and to also consecutively rename the remaining elements. Claims 3, 6-8, 14-17, 23, 25, 26, 28, and 32-42 are withdrawn without prejudice in view of the restriction and species election. Claim 13 has been amended to correct a minor typographical error. Claim 29 has been cancelled without prejudice. Claim 30 has been amended to recite the chemical structures for the claimed compounds from Table 2 of the specification. Claim 43 has been added to recite a pharmaceutical composition according to claim 30. Claim 44 has been added to recite a subset of the Markush group for “G” from claim 1. Claim 45 has been added to mirror claims 18 and 19. Claims 46-48 have been added to recite a pharmaceutical composition according to claims 18, 19, 44, and 45, respectively. The remaining claims are either original or previously amended. The Abstract has been replaced by a new abstract. Antecedent basis for the new abstract is found at least at page 6, lines 9-17 of the specification.

Support for these amendments is found in the as filed specification and claims. No new matter has been added by any of the foregoing amendments.

Applicants preserve their right to present the cancelled or withdrawn claims and subject matter in this or a related application.

Applicants submit herewith a supplemental Information Disclosure Statement. The Examiner is respectfully requested to initial the entry and make the statement of record.

The outstanding objections and rejections are discussed in the order in which they appear in the Office Action.

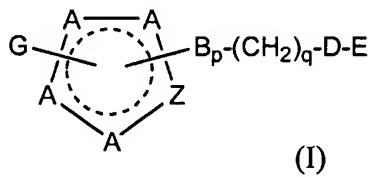
### **Priority**

Applicants note the comments in the Office Action regarding the priority claim. The present application is an application for a patent which contains subject matter disclosed in, and therefore properly claims priority to U.S. Provisional Application Nos. 60/414,207 (“the ‘207 application”), filed September 26, 2002 and 60/448,216 (“the ‘216 application”), filed February 19, 2003. The generic structure present in the instant application was redrawn and the variables renamed and/or redefined relative to the disclosure in the ‘207 and ‘216 applications upon conversion. For example, in the present application, the instant variable “G” was formerly designated as “R<sup>1</sup>” in both the ‘207 and ‘216 applications. Upon entry of the present amendment, the sub-element “g) C1-8 acyl” recited in “G” is deleted.

### **Response to Election/Restriction**

The Office has issued a restriction requirement under 35 U.S.C. § 121. This restriction requirement was orally presented to Applicants’ previous counsel, Attorney, Duncan Greenhalgh, during a telephone conversation on June 16, 2005. The restriction is presented in the Office Action and can be summarized as follows:

- I. Claims 1-31, drawn to compounds having the formula (I),



classified in various subclasses of various classes such as class 544, subclass 137, class 548, subclass 229, class 546, subclass 256, for example.

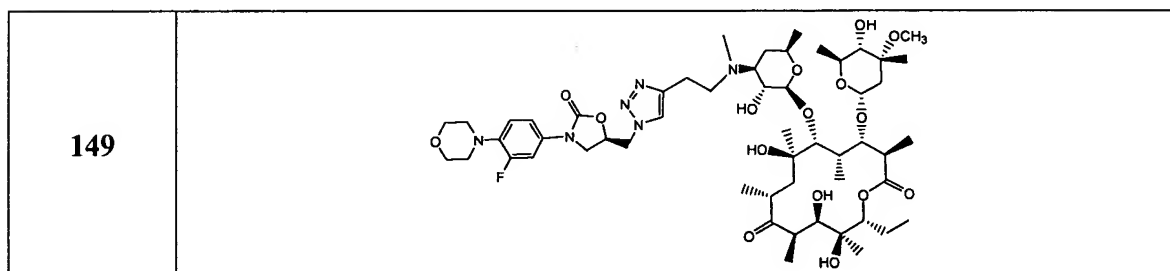
- II. Claims 32-39, drawn to a method of treatment, classified in class 514, subclass 377.

III. Claim 40, drawn to a process of making compounds according to claims 1-30, classified in class 514, subclass, 377.

IV. Claims 41-42, drawn to a medical device, classified in class 604, subclass 19, for example.

The Office Action also indicates that where an election of Group I or III is made, an election of a single species is further required. The Office Action also indicates that where an election of Group II is made, an election of one of the further recited methods is required.

Applicants affirm the oral election, with traverse, made by Attorney Greenhalgh on June 16, 2005, of Group I, i.e. Claims 1-31, and the election of species of Compound 149 (Table 2, page 170 of the specification and shown below).



Applicants submit that it would not be unduly burdensome to also search for methods and medical devices associated with the searched compound classes. Applicants also preserve their right to rejoin Groups II and III in this application and also preserve the right to pursue the non-elected matter in additional applications.

**Rejection Under 35 U.S.C. §102**

Applicants note the comments in the Office Action regarding the priority claim. The present application is an application for a patent which contains subject matter disclosed in, and therefore properly claims priority to U.S. Provisional Application Nos. 60/414,207 ("the '207 application"), filed September 26, 2002 and 60/448,216 ("the '216

application”), filed February 19, 2003. The generic structure present in the instant application was redrawn and the variables renamed and/or redefined relative to the disclosure in the ‘207 and ‘216 applications upon conversion. For example, in the present application, the instant variable “G” was formerly designated as “R<sup>1</sup>” in both the ‘207 and ‘216 applications. The definition for “G” in the present application (before the present amendment) recited the sub-elements “a) – q)”, including the sub-element “g) C<sub>1-8</sub> acyl.” The definition for “R<sup>1</sup>” in both the ‘207 and ‘216 applications, recites sub-elements “a) – s)”, but does not specifically recite a sub-element corresponding to C<sub>1-8</sub> acyl. Notwithstanding the forgoing, any potential question of priority with respect to, e.g. the C<sub>1-8</sub> acyl group recited in G is moot in view of the amendments to claim 1.

Claims 1, 2, 4, 5, 9, 10, 11, 12, and 13 have been rejected under 35 U.S.C. 102(a) as being anticipated by Phillips, O.A.; Udo, E.E.; Ali, A.A.M.; Al-Hassawi, N. *Bioorg & Med. Chem.* **2003** 11 (1), p. 35-41 (Available online 18 October. 2002), (“Phillips”).

Applicants submit that in view of the amendment to Claim 1 that the rejection is overcome. Withdrawal of the rejection is respectfully requested.

**Rejection Under 35 U.S.C. §112, Second Paragraph**

Claims 29 and 30 have been rejected under 35 U.S.C. §112, second paragraph. The Office Action states at page 19:

Claims 29 and 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 29 recites “a compound having the structure corresponding to any of the structures listed in Table 1.” Claim 30 recites “a compound having the structure corresponding to any of the structures listed in Table 2.” Claims shall not refer to the specification and/or drawings. See Ex parte Fressola, 27 USPQ 2d 1608, 1609 (BPAI 1993). To overcome this rejection, Applicant must amend the claims in a format that particularly defines the compounds of the invention.

Claim 29 has been cancelled herein. Thus, the rejection as applied to this claim is moot and should be withdrawn. In view of the amendment to claim 30, which

incorporates the structures of the compounds of Table 2, the rejection has been overcome as applied to this claim. Withdrawal of the rejection is respectfully requested.

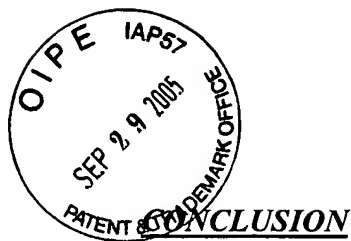
The Office Action also states that “Claim 13 recites the limitation ‘the compound according to claim 11, wherein t is 1.’ However, claim 11 does not recite the variable ‘t’ there is insufficient antecedent basis for this limitation in the claim.

Claim 13 has been amended to correct the typographical error, and now recites the variable x. In view of this amendment, the rejection has been overcome and withdrawal of the rejection is respectfully requested.

### **Objections**

The Examiner requests revision of the content of the abstract. The Office Action states that “[t]he abstract of the disclosure is objected to because the abstract lacks an exemplary generic structure of the compounds of the invention. Additionally, the abstract contains the numbers “2682693” at the bottom of the page, which may or may not be a typo. Correction is required. See MPEP § 608.01(b).”

Applicants respectfully traverse the rejection, indicating that a generic chemical structure is not required in an abstract and that the numbers at the bottom of the abstract page are Applicants’ outside counsel’s document reference code. However, to further the prosecution of the application, Applicants have amended the abstract to include a generic structure and have deleted the document reference code. Withdrawal of the rejection is respectfully requested.



In view of the foregoing, Applicants respectfully request reconsideration and allowance of the claims and rejoinder of the non-elected subject matter.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Ivor R. Elrifi', written over a horizontal line.

Ivor R. Elrifi, Reg. No. 39,529  
Heidi A. Erlacher, Reg. No. 45,409  
Attorneys for Applicants  
Mintz, Levin, Cohn, Ferris,  
Glovsky and Popeo, P.C.  
Tel: (617) 542-6000  
Fax: (617) 542-2241

**Customer No.: 30623**

Date: September 29, 2005